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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,672

Applicant(s)

CUPP ET AL.

Examiner

Keith Hendricks

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1761

DETAILED ACTION

Priority

It is noted that this application claims priority to PCT/EP01/00307 and US application 09/483,328. However, it is noted that the subject matter of claims 21-35 does not find support in the 09/483,328 application, and thus the effective priority date for this subject matter is January 10, 2001, the filing date of PCT/EP01/00307.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

i) Claims 1-5, 7-11, 13-16, 18-20, 26, 29, 32 and 35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Simone et al. (US PAT 5,407,661). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive.

At page 8 of the response, applicant states that the "chew product" of Simone et al. cannot be compared to the "pet food" product of the instant claims. This is not deemed persuasive. The invention of Simone et al. "is directed to an edible animal chew product", which is fed to dogs and swallowed by the dogs. See the examples, especially at column 8 of the reference. "The dogs were fed the canned dog food at about 8 am and two (2) chews at about 10am" (col. 8, ln. 32-33), where "the spongy cellular chew product was chewed repeatedly before being swallowed". Applicant's label of their product as a "food", versus a "chew" product, does not serve to patentably distinguish the claimed invention from the prior art. Furthermore, the recitation of "pet food" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely

Art Unit: 1761

recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the recited elements of the claimed invention are anticipated by the reference, regardless of how applicant chooses to label their product.

Regarding the use of corn cob fractions as a source of insoluble fiber, applicant states that “nowhere does Simone suggest that this level and type of fiber source is suitable for making dried pet food products.” This is not deemed persuasive for the reasons of record, which specifically addressed this limitation and demonstrated how the invention of Simone et al. anticipates the instant claims in this regard. Applicant has provided no convincing evidence or argument to the contrary. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

At page 9 of the response, applicant argues that the density of the referenced product differs from the range of the instant claims, basing this argument on the statement that the chew product of the reference has a final moisture content of 20%. This is not deemed persuasive for the reasons of record. Just as applicant's disclosure is not necessarily limited to the examples provided, neither is that of the referenced patent. While the referenced example stated that the product had a moisture content of 20%, the reference also stated that, after extrusion and segmentation (cutting), “the chew particles are then allowed to cool and dry... to adjust the moisture level to about 10 to about 30% by weight” (bottom col. 5). Thus, a difference of 10 percent in either direction from the exemplified moisture content would be expected to alter the density proportionately, and would provide a product with a density within the instantly-claimed amounts, as previously stated on the record.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., insoluble fiber content/percentage, density level, etc.) are not recited in each of the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 1761

ii) Claims 7-9, 11-12, 18, 28-29 and 34-35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Gellman et al. (US PAT 4,743,460). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive.

At pages 9-10 of the response, applicant states that "the Patent Office admits that the insoluble fiber feature of the rejected claims is not specifically mentioned as an ingredient; yet the Patent Office still maintains its anticipation rejection with respect to Gellman et al." Further, applicant states that "Gellman is not concerned with whether or not the fiber that is provided is soluble or insoluble. In this regard, Gellman merely uses starchy substances to aid in the cost reduction of the product."

This is not deemed persuasive for the reasons of record. As specifically addressed in the previous Office action, insoluble fiber is not specifically mentioned as an ingredient in Gellman et al.; however, the farinaceous materials described at column 10 *naturally contain some amount of fiber*. For example, wheat generally contains 2.3- 5.6% total dietary fiber, with 1.7% of that insoluble, including cellulose. Corn flour has 15% insoluble fiber, including cellulose (reference to standard textbook in the art, for example, pg. 481, 484. Lorenz et al. "Handbook of Cereal Science and Technology", Dekker Press, 1991). Thus, the referenced products *necessarily* contain insoluble fiber as a result of inclusion of these components. Although this does not reach the threshold of "about 2% to about 15%" (instant claims 4,10, and 16, which are not rejected over this reference), the instantly-rejected claims, which simply require the *presence* of insoluble fiber, are anticipated by the reference.

iii) Claims 1-20, 21, 26, 29, 32 and 35 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hand et al. (US PAT 5,431,927). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive.

At page 10 of the response, applicant states that

contrary to the Patent Office's interpretation, Hand fails to disclose or arguably suggest the dimensional features of the claimed invention. For example, Hand fails to teach any specifics regarding the length of a pet food product with respect to the width and thickness. Applicants question how Hand could conceivably convey the length feature of the claimed invention based on its sole teaching regarding the diameter of a disc shaped pellet as suggested by the Patent Office.

Art Unit: 1761

Applicant also states that "Hand clearly fails to teach or arguably suggest the matrix characteristic features of the claimed invention which include density and size characteristics, such as length, width and thickness."

This is not deemed persuasive for the reasons of record. Applicant has failed to address the specific points of the rejection as set forth in the previous Office action. In the previous action, it was stated that at column 5, the reference states that the product may be in any of several shapes, and is preferred as a disc-shaped pellet having a thickness of about 0.32 to 0.70 inch (about 8mm to 17mm), and a length/width "diameter of about 0.7 to about 1.2 inch" (17.7 - 30.48 mm). The example product was cut into about 12mm (0.5 inch) thick pellets and fed to dogs. Finally, the product has a density ranging from "about 10 to about 35 lbs/ft³". These dimensions of size and density are specifically taught by (and quoted from) the reference, and thus it is unclear as to how applicant may make the assertion that the reference "fails to teach or arguably suggest" these features. Thus and again, the reference anticipates the claimed invention, and applicant's arguments are not deemed persuasive for the reasons of record.

iv) Claims 21, 24-25, 27-28, 30-31 and 33-34 remain rejected under 35 U.S.C. 102(e) as being anticipated by Wang (US PAT 6,455,083). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive.

At page 11 of the response, applicant states that

Each of the rejected claims depend from one of independent claims 1, 7, 13, 18 and 20. Yet, the Patent Office does not appear to reject any of independent claims 1, 7, 13, 18 and 20 in view of Wang. indeed, the rejected claims incorporate each of the features of their respective independent claims as a matter of law. Therefore, Applicants believe that Wang fails to disclose or suggest the subject matter as defined in claims 21, 24-25, 27-28, 30-31 and 33-34 for substantially the same reasons as Wang fail to disclose or suggest the subject matter as defined by their respective independent claims as the Patent Office even appears to admit.

This is not deemed persuasive for the reasons of record. As stated at the top of the first page of this and the previous Office action, "the subject matter of claims 21-35 does not find support in the 09/483,328 application, and thus the effective priority date for this subject matter is January 10, 2001, the filing date of PCT/EP01/00307." While dependent, as applicants correctly point out, claims 21, 24-25, 27-28, 30-31 and 33-34 may also be re-written in independent form, and are to be interpreted as such for examination purposes, each individually examined on its own merits. Thus, while the reference is not eligible prior art against the broad independent claims 1, 7, 13, 18 and 20, it is properly applicable to the

Art Unit: 1761

newly-added subject matter of claims 21-35. In fact, a lack of such a rejection over the dependent claims, as presented herein, would be improper in light of the teachings of the reference, especially given that applicant could simply re-write the claims in independent form. Thus, although not in a conventional format at first glance, the rejection is proper, and is maintained for the reasons of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-17 and 19-20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman et al.

Gellman et al. is taken as cited above. Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive. Applicant appears to rely upon the arguments presented with respect to the 102(b) rejection above. Applicant's statements at page 11 of the response do not specifically address the instant rejection, and as the 102(b) has been maintained above, the instant rejection is thus maintained for the reasons of record.

Claims 22-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hand et al., taken as cited above, in view of Schommer et al. (US PAT 5,887,749). The references and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 25, 2003, have been fully considered but they are not persuasive.

At page 12 of the response, applicant states that the rejection "merely relies on Schommer for its purported teachings regarding mixing both wet and dry pet foods. Therefore, Applicants do not believe that one skilled in the art would be inclined to modify Hand in view of Schommer to arrive at the claimed invention." This is not deemed persuasive for the reasons of record.

As previously addressed, column 1 of the reference states that it was known that pets prefer both wet and dry foods, that "in the past, pet owners have purchased dry pet food and canned wet food in separate containers, and then mixed them to feed their pet", and thus in order to provide a simplified

Art Unit: 1761

procedure, the patent teaches the mixing of dry and wet pet foods. Thus, as this patent provided this general and simple knowledge with regard to the state of the art at the time the invention was made, and specifically stated that pets prefer both wet and dry foods, this provided positive motivation for one of ordinary skill in the art to utilize this technique with known dry pet foods in general, in order to provide a more appealing food composition to the pet, thus also increasing the market value of such products. The teachings of the Schommer et al. reference demonstrate that this was a common step in providing pet food in the art, and therefore it would have been obvious to one of ordinary skill in the art to have performed this commonly-known method of pet food mixing, for example with the known food of Hand et al. Again, the selection of the amount of both dry and wet foods would not have involved an inventive step, and would have been well within the ordinary level of skill in the art to have provided an approximately equal balance of wet food and dry food.

Double Patenting

i) Claims 1-20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/154,646.

ii) Claims 1-20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/052,949.

iii) Claims 1-20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/037,941.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both directed to pet food chew products (and methods of use) of various sizes, with the same density properties and overlapping ingredients of denatured proteins and starches, insoluble fibers, etc. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1761

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



**KEITH HENDRICKS
PRIMARY EXAMINER**